



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,136	02/20/2004	Tony M. Pearce	03886.051/5126 P	5374

7590 10/03/2005

Parsons Behle & Latimer
Suite 1800
201 South Main Street
P.O. Box 45898
Salt Lake City, UT 84111

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,136

Applicant(s)

PEARCE, TONY M.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-122 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 7,8,10,11,16,26,27,32,40-72,74,75,82,83,86,87,89-95,97,98,101,102,104-111,119 and 120.

Continuation of Disposition of Claims: Claims rejected are 1-6,9,12-15,17-25,28-31,33-39,73,76-81,84,85,88,96,99,100,103,112-118,121 and 122.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of four separate genii of the claimed invention:

A. Genus of polymer B:

- a. wherein the polymer B is a hydrogenated copolymer including both isoprene and butadiene monomer units. (claims 3, 4, 9 and 25-39)
- b. wherein the polymer B is hydrogenated polyisoprene. (claim 7)
- c. wherein the polymer B is hydrogenated butadiene. (claim 8)
- d. wherein B is a hydrogenated copolymer of ethylene/propylene and ethylene/butylenes. (claims 40-72)

B. Genus of bleed reducing agent:

- a. wherein the bleed reducing agent is a hydrocarbon.
(claims 10,11,26,27,41,42,57,58,74,75,82,83,86,87,97,98,101,102,119 and 120)
- b. wherein the bleed reducing agent is a fluorochemical alcohol (claims 12, 13, 28, 29, 43,44, 59, 60, 76, 77, 85, 99, 100, 121, 122)

C. Genus of material:

- a. wherein the material is mostly composed of gas pockets. (claims 16, 32, 47 and 63)

Art Unit: 1713

- b. wherein the material is mostly composed on microspheres. (claims 19, 35, 51 and 66)

D. Genus of further additive:

- a. wherein the further additive is a melt temperature modifier. (claims 88 and 103)
- b. wherein the further additive is a tack modifier. (claims 89, 90, 104 and 105)
- c. wherein the further additive is a foam facilitator. (claims 91 and 106)
- d. wherein the further additive is a flame retardant. (claims 92 and 107)
- e. wherein the further additive is a melt viscosity modifier. (claims 93, 94, 108 and 109)
- f. wherein the further additive is a shrinkage reducer. (claims 95 and 111)
- g. wherein the further additive is a tensile strength modifier. (claim 110)

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each Genus for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Daniel P. McCarthy on 9/22/05, a provisional election was made with traverse to prosecute the invention of Species A) a., B) b., C) b. and D) a., claims 1-6, 9, 12-15, 17-25, 28-31, 33-39, 73, 76-81, 84, 85, 88, 96, 99, 100, 103, 112-118, 121 and 122. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8, 10, 11, 16, 26, 27, 32, 40-72, 74, 75, 82, 83, 86, 87, 89-95, 97, 98, 101, 102, 104-111, 119 and 120 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 88 and 103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. These claims recite the limitation "the additive" in their independent claims. However, since their individual independent claims recite more than one additive, it is unclear what additive "the additive" is further defining. Thus, there is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 9, 14, 15, 17-25, 30, 31, 33-39, 73, 78-81, 88, 96, 103 and 112-118 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce (USPN 5,994,450)

The entire disclosure of 5,994,450 anticipates these claims.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Art Unit: 1713

NOTE: Regarding the priority claim, it is noted that the parent of the C-I-P case of which the present application is a divisional, US. 09/303,919, does not provide support for the presently claimed elastomeric material with a bleed-reducing agent. As the claimed composition is not supported by said domestic priority application, the oldest priority application with support for the claimed invention is 10/059,101, filed 11/08/2001.

9. Claims 1-6, 9, 12-15, 17-25, 28-31, 33-39, 73, 76-81, 84, 85, 88, 96, 99, 100, 103, 112-118, 121 and 122 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce (USPN 6,026,527)

The entire disclosure of 6,026,527 anticipates these claims.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 14, 17, 21-25, 30, 37-39, 73, 78-80 and 112-118 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,756,195).

Art Unit: 1713

In col. 2, lines 26-40 and col. 5, lines 49 to col. 6, line 26, Allen et al. teach an elastomeric material comprising a triblock copolymer elastomer of the configuration A-B-A, block A being a non-elastomeric styrenic polymer and block B being an elastomeric polymer, a plasticizer combined with said triblock copolymer elastomer, and an additive to reduce bleeding in the rubber.

While Allen et al. do not expressly teach the disclosed properties of the claimed material, such as % elongation and rigidity, it is reasonable that the material of Allen et al. would possess the presently claimed properties since the composition of Allen et al. is essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. *In re Fitzgerald et al*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

Art Unit: 1713

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-6, 9, 12-15, 17-25, 28-31, 33-39, 73, 76-81, 84, 85, 88, 96, 99, 100, 103, 112-118, 121 and 122 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,187,837. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of 6,187,837 cannot be practiced without the invention of the present claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

A handwritten signature in black ink, appearing to be 'KELECHI C. EGWIM', written over a horizontal line.